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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,878	06/29/2000	Akira Uchiyama	551512/062	6860

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EXAMINER

TALBOT, BRIAN K

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 06/06/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/606,878

Applicant(s)

UCHIYAMA, AKIRA

Examiner

Brian K Talbot

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1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-18,20-24 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,12-16,24 and 40 is/are allowed.
- 6) ☒ Claim(s) 5-7,23,41 and 42 is/are rejected.
- 7) ☐ Claim(s) 8-11,17-18 and 20-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>19</u> | 6) <input type="checkbox"/> Other _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/15/03 has been entered.

2. Claims 41-42 have been added. Claims 1,5-18,20-24 and 40-42 remain in the application.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

4. Claims 5-7 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 5,6 and 23, the claims are dependent upon a canceled claim (claim 4).

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With respect to claim 6, the term "original liquid" is vague and indefinite as well as lacking antecedent basis.

With respect to claim 7, the term "removing" should be "eliminating" so as to avoid a rejection of lacking antecedent basis.

Claims 8-11, 17-18 and 20-22 are objected to as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 103

Claims 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP-63-11563 in combination with JP-04-41656.

JP-63-11563 teaches coating watchcases and bands comprising titanium with a protective layer of glass. The titanium material is cleaned, washed and dried prior to applying the protective glass coating.

JP-63-11563 fails to teach machine working the titanium material by honing, nicking or mirror finishing the titanium surface and then cleaning the surface prior to applying the protective glass layer.

JP-04-41656 teaches polishing/finishing a titanium material.

Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have had a reasonable expectation of success for utilizing JP-04-41656 titanium product in JP-63-11563 process to form the watchcase and band.

Allowable Subject Matter

5. Claims 1,12-16,24 and 40 allowed.
6. Claims 5-11,17-18,20-23 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Reasons for Allowance

7. The following is a statement of reasons for allowance:

The prior art of record fails to teach or fairly suggest a method of treating a titanium surface which has been subjected to honing, nicking or mirror finishing whereby a glass coating is applied after substances are removed following said honing, nicking or mirror finishing whereby the glass coating is selected to have a viscosity of 200-500 cps at 25°C when the titanium surface has been honed or nicked and a viscosity between 150-250 at 25°C when the titanium surface has been mirror finished. The prior art teaches applying a glass protective layer to a titanium surface after a treatment step, however, no "selection" step with regards to the viscosity is taught based on the type of treatment performed.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6357 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.



Brian K Talbot
Primary Examiner
Art Unit 1762

BKT
June 6, 2003